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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,040

08/10/2006

Antonio Francisco Espinosa

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RANKIN, HILL & CLARK LLP  
38210 GLENN AVENUE  
WILLOUGHBY, OH 44094-7808

EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

08/31/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

40854@rankinhill.com  
spaw@rankinhill.com



<b>Office Action Summary</b>	<b>Application No.</b> 10/589,040	<b>Applicant(s)</b> ESPINOSA, ANTONIO FRANCISCO	
	<b>Examiner</b> Margaret G. Moore	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17, 59, 60, 71 to 110 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 59, 60, 71 to 110 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |



1. Claims 17, 59, 60 and 71 to 110 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of the language found in claim 17 is maintained from the previous office action. Applicants' traversal is not persuasive. It is argued that one must meet the requirement of having a sum of titanate and/or zirconate and silane based binder first, and then select from within the ranges found in the claim. This is not clear from the language used in the claim, which doesn't indicate that one limitation takes priority over the other. The language of the claim does not indicate that the total sum of components takes precedence over the individual amounts of each component, in view of the fact the amount of silane can be greater than the total sum of components. It is confusing and contradictory to indicate that 25 % of a silane based binder can be present when applicants arguments are that this is in fact not allowed from the "wherein" language. Clarification is required.

In new claim 97, since the term "and" is present prior to "combinations thereof" the claim reads that both thickening agent and wetting agent are present in the cumulative rather than the alternative. Since this claim uses the phrase "combinations thereof" it appears that it intends for a thickening agent and a wetting agents to be present in the alternative. Clarification is required. The examiner notes that the use of Markush language in other claims clearly reflects the breadth of those claims. Inserting "selected from the group consisting of" prior to "thickening agent" would clarify this claim.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 17, 59, 60, 71 to 74, 78 to 85 and 97 to 110 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Krienke et al.



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The teachings of Krienke et al. and how they apply to the instant claims were noted in the previous office action. Applicants have amended claim 17 to require a baking temperature of from 180°C to 350°C. This changes the basis of this rejection such that it is now a product by process type rejection.

As applicants are do doubt aware, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Please note MPEP 2113, which addresses making a rejection under 35 USC 102/103 for product by process claims.

In the instant application, the Examiner acknowledges that Krienke et al. do not teach a baking temperature within the claimed range. Applicants have not established, though, that such a temperature results in a different coated substrate than that claimed.

To support applicants' position of patentability they provide a Declaration by inventor Chesneau. This Declaration, which relies on the inventors' opinion rather than providing any factual evidence or data, is not sufficient to distinguish the claims from the prior art. It is asserted but not proven that the baking temperature in Krienke is not sufficient to confer anticorrosion properties. The Examiner notes, though, that the prior art coating composition is referred to as having corrosion resistance (see for instance column 1, line 18). As such applicants' opinion to the contrary is not sufficient. The Declaration makes reference to a saline resistance test but applicants have not shown any comparative evidence.

The Declaration also refers to a three dimensional structure in the claimed coating and bonding to the substrate. The coating in Krienke et al. is both three dimensionally crosslinked and bonded to the substrate. Since applicant's Declaration apparently attributes resistance to saline to the formation of a three dimensional structure and/or bonding to the substrate, it would appear then that the coated substrate in Krienke et al.



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will inherently possess the same resistance to saline properties as the claimed composition.

With this in mind, applicants have failed to establish that the product by process claimed is different from the product in Krienke et al.

For new claim 73, please note that this does not actually require that the titanates listed be present.

4. Claims 86 to 91 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krienke et al.

This rejection rationale is consistent with that noted in paragraph 6 of the previous office action, as these claims correspond to previously pending claims 9, 10, 33 to 36 and 42. Since applicants rely on the limitations in claim 17 for patentability, and since claim 17 remains rejected over Krienke et al., these claims are also rejected.

5. Claims 75 to 77 and 95 to 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krienke et al. as applied to claim 17 above, and further in view of WO 01/85854.

This rejection rationale is consistent with that noted in paragraph 7 of the previous office action, as these claims correspond to previously pending claims 4, 13, 27, 28 and 38 to 41. Since applicants rely on the limitations in claim 17 for patentability, and since claim 17 remains rejected over Krienke et al., these claims are also rejected.

6. Claims 93 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krienke et al. as applied to claim 17 above, and further in view of Horie et al.

This rejection rationale is consistent with that noted in paragraph 8 of the prior office action, as these claims correspond to previously pending claims 12 and 37. Since applicants rely on the limitations in claim 17 for patentability, and since claim 17 remains rejected over Krienke et al., these claims are also rejected.



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7. Claims 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krienke et al. as applied to claim 17 above, and further in view of Takahama et al.

This rejection rationale is consistent with that noted in paragraph 9 of the prior office action, as these claims correspond to previously pending claims 11 and 12. Since applicants rely on the limitations in claim 17 for patentability, and since claim 17 remains rejected over Krienke et al., these claims are also rejected.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1796

mgm  
8/26/10